

**REMARKS**

Reconsideration of the application is requested in view of the amendments to the claims and the remarks presented herein.

The claims in the application are claims 1, 2, 5 to 23, 26 and 27, all other claims being cancelled. Claims 13 to 23 are withdrawn. Applicants repeat their request that claims 13 to 23 be rejoined with the elected claims if found allowable.

Claims 1 to 12, 26 and 27 are rejected under 35 USC 03 as being obvious over the Japanese reference taken in view of the Giersberg et al patent. The Examiner states that the Japanese patent teaches a tin and iridium oxide or platinum plating on an anode wherein the anode is a valve metal and the tin/iridium or palladium coating includes a stannous chloride followed by heating at 400-600°C. The Examiner concedes that the Japanese reference fails to teach the claimed compound formula but cites Giersberg et al teaches a stoichiometric stannous hydroxychloride and a non-stoichiometric stannous hydroxyoxalate having a formula similar to that claims (abstract and claims 1-3). Therefore, it would have been obvious at the time the invention was made to have modified the Japanese patent to have utilized the compound formula of Giersberg et al. with the expectation of achieving similar success.

Applicants traverse this ground of rejection since the combination of the prior art cited by the Examiner with the benefit of Applicants' teaching would not be led to Applicants' invention. The Japanese patent is directed to the manufacture of an anode by pyrolytic decomposition of stannous chloride which is not the precursor of the present invention.

The Giersberg et al patent is directed to a method of coating glass vessels, which is totally unrelated to the field of electrode manufacturing. Moreover, Giersberg et al teaches compounds different from the claimed ones. The stoichiometric stannous hydroxychloride cited in Giersberg et al is not "a non-stoichiometric compound expressed by the formula  $\text{Sn}(\text{OH})_{2+x}\text{Cl}_{2-x}\text{nH}_2\text{O}$ ", and the non-stoichiometric stannous hydroxyoxalate of Giersberg has not at all a formula "similar to that claims" as alleged by the Examiner. Stannous hydroxyoxalate is not even a chlorinated compound, while the claimed  $\text{Sn}(\text{OH})_{2+x}\text{Cl}_{2-x}\text{nH}_2\text{O}$  and  $\text{SnO}(\text{H}_2\text{O})_n\text{R}_{2-x}\text{Cl}_x$  contain chlorine. This makes a crucial difference, as any learned chemist would readily know.

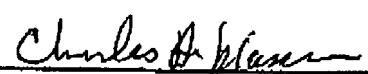
The allegation that it would have been obvious to have used the formula of Giersberg et al, which is totally unrelated to the technical field of the invention, to modify the Japanese patent "with the expectation of achieving similar success" is totally unfounded: Firstly, the formula of Giersberg et al is not the formula of the invention, so that a person of skill in the art could not have used it to modify the Japanese patent. Secondly, "the expectation of achieving a success" is strictly related to the technical problem tackled. The present invention solves the problem of enhancing the reproducibility and reliability in the preparation of electrode coatings, for instance of coatings containing tin and a noble metal such as ruthenium, avoiding the volatilisation of an excessive amount of tin precursor with respect to the noble metal precursor during the preparation, which would lead to an unpredictable noble metal to tin (e.g. Ru:Sn) molar ration in the coating (see pages 2 and 3 of the specification). The Japanese patent does not tackle this technical problem nor does it acknowledge the need to overcome this drawback. Giersberg et al patent is concerned in "achieving a success" in coating glass vessels, wherein the need to have a reliable and reproducible ration of tin to noble metal in the final coating does not exist, because no noble metal is co-deposited. The combination of the Japanese patent with Giersberg et al patent in

this regard is hence devoid of any meaning and a person of skill in the art would not have taken it into consideration.

As regards to the Examiner's allegation that the "stoichiometry would be a matter of design choice", Applicants do not subscribe to this position. A person of skill in the art would normally bother selecting a non-stoichiometric compound only in the presence of a definite reason for doing so. Such reason is not apparent in the art of coating glass vessels. Additionally, Giersberg et al teaches a Cl:Sn equal to 1, which clearly reads on a stoichiometric compound, thereby teaching away from the instant invention. As regards the Examiner's reference to pending claim 2, Applicants point out that claim 2 depends on claim 1 and hence reads on a "non stoichiometric compound wherein the Cl:Cn is between 1 and 1.9"; the limitation "non-stoichiometric" compound makes clear that the lower limit 1 is outside the claimed range, since a Cl:Sn ratio equal to 1 would definitely read on a stoichiometric compound. Therefore, Applicants request withdrawal of this rejection.

In view of the amendments to the claims and the above remarks, the claims are believed to point out Applicants' patentable invention. Therefore, favourable reconsideration of the application is requested.

Respectfully submitted,

  
\_\_\_\_\_  
Charles A. Muserlian #19,683  
Attorney for Applicants  
Tel. 212 302 8989

CAM:mlp  
Enclosures

**CERTIFICATION OF FACSIMILE TRANSMISSION**

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

Charles A. Muserlian  
Charles A. Muserlian #19,683

11-9-09

Serial No. 10/563,852

267.196